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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,366	07/11/2007	Robert Thompson	16489-55172	3050
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EXAMINER				
SHAH, MILAP				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,366

Applicant(s)

THOMPSON ET AL.

Examiner

Milap Shah

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 7 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

This action is in response to the amendment received November 13, 2008. The Examiner acknowledges that claim 1 was amended, claims 2-6 were canceled, and claim 7 was added. Therefore, claims 1 and 7 are currently pending. Claim 7 is withdrawn as being directed to a non-elected invention in view of the election/restriction requirement set forth below. Claim 1 is examined herein.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to method of providing a video game on a limited play optical medium, classified in class 463, subclass 43.
- II. Claim 7, drawn to business method of marketing a video game and selling the video game at a discount, classified in class 705, subclass 14.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as a method of marketing and selling a video game that does not dependent on the specific video game of Invention I. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations

of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 7 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.42(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended claim 1 recites that the contents of the video game are to be “presented to a user that are to be played through before said playability period ends”. The Examiner fails to find disclosure in the originally filed specification to specifically support that the content of the video game on the limited play optical medium is required to be played through before the playability period ends. The specification appears to suggest that the limited play optical medium has a predetermined time period associated with the reactive material, that when opened or exposed, initiates a predetermined time before the content expires. However, such does not positively require a user to play the content through before the playability expires. For instance, a player may use the optical medium today without completing the content. According to the specification, at some later time, for example a week, the content expires (i.e. time versus playability). Therefore, the Examiner concludes the newly added limitation does not appear to be supported by the originally filed specification. This is a new matter rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “...the video game comprises a segment and/or single stage and/or level and/or sample...”, where the use of the phrase “and/or” causes the limitation to be indefinite. It is unclear if the video game must include a segment and a level or a segment and a sample or a single stage and a level and so on. The Examiner suggests the following language: “...video game comprises one of a segment, a single

stage, a level, or a sample". It appears the intended limitation is to be in the alternative, thus, this language appears to convey such in a clear manner.

Claim 1 also appears indefinite as it recites the reactive material limits the length of time the video game is playable, however, also requires the content to be played through before the playability period ends. Clearly a player *may* play a game through before the playability period ends, however, it does not appear that such is always the case, therefore, it is unclear if a time factor makes the optical medium unplayable or the action of playing the optical medium through makes the optical medium unplayable. For examination purposes, it appears that "...that are to be played through before said playability period ends." is mere intended use. The Applicant's specification appears to support intended use such as paragraph [0022] in which the Applicant suggests a possible "game scenario may be a spy theme wherein the end user has to complete a number of missions before the life of the media ends". Although, such disclosure does not appear to support the player playing the spy game to the end triggers the expiration of the media.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Wisnudel et al. (U.S. Patent Application Publication No. 2005/0025988, filed August 1, 2003).

Claim 1: Wisnudel et al. disclose the same invention for playing a video game (paragraph 0003 discloses possible uses for the limited life data storage as being for video games) comprising

providing a video game on a limited play optical medium, wherein the limited play optical medium comprises a reactive material for limiting the length of time the video game is playable (abstract, and paragraphs 0002-0008, where video game content is one of a plurality of disclosed content that may be stored on a limited play optical medium, such as CD or DVD, having a reactive dye to facilitate limited play of said optical medium), and wherein the video game comprises a segment, a single stage, a level, or a sample presented to a user that are to be played through before the playability period ends (clearly the recitation of “video game” suggests that content directed to a video game is stored on the limited play data storage, such content may be referred to at least a segment or a sample in a broadest reasonable interpretation, wherein as discussed above, the intended use in the instant claim, requires playing the content through before the playability period ends, where such situation is possible given the disclosure of Wisnudel et al., as the playability period appears to be numerous days, given sufficient *time* to a user to play the content through).

Response to Arguments

Applicant's arguments with respect to claim 1 has been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Applicant is directed to the attached “Notice of References Cited” for additional relevant prior art. The Applicant is requested to review each reference as potentially teaching all or part of the claimed invention. Frankly, the “video game” recitation in the claims is merely intended use of the limited play optical medium, as the video game is merely one of numerous contents recordable on optical medium.

Thus, given these references teaching limited play data storage and absent any disclosure of video game content, it would have been obvious to one of ordinary skill in the art to implement video game content using similar technology for any other available content on limited play data mediums.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571)272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/MBS/

/Scott E. Jones/
Primary Examiner, Art Unit 3714